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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/804,292
Filing Date: March 19, 2004
Appellant(s): PECEN ET AL.

Gary J. Cunningham
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/18/2007 appealing from the Office action mailed 3/7/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 4/16/2007 has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0160785	Ovesjo et al.	10-2002
7,050,812	Boyer et al.	5-2006
2004/0157600	Stumpert et al.	8-2004
7,065,360	Yahagi	6-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-4, 7-8, 18, 20, and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaheen et al. (US Pat Appl# 2004/0203792).

Regarding claim 1, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system teaches a method in a communication device for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7), the first radio access network using a different mode of communication from the second radio access network (Section 0018), the method comprising entering an ongoing communication on the first radio access network UMTS (Fig. 7); detecting a presence of a second radio access network

S6 (Fig. 7), the second radio access network being unregistered with the first radio access network at initial detection of the presence of the second radio access network while in the ongoing communication (Fig. 7 and Sections 0039-0043); and transferring the ongoing communication from the first radio access network to the second radio access network S16-S21 (Fig. 7 and Sections 0006-0009 and 0039-0043), wherein the first radio access network is a cellular radio access network (UMTS) and wherein the second radio access network is a wireless local area network (Fig. 7 and Sections 0006-0009 and 0039-0043).

Regarding claim 3, Shaheen teaches wherein the second radio access network is unregistered with the first radio access network by the first radio access network not initially having information on the second radio access network (Fig. 7 and Sections 0006-0009 and 0039-0043).

Regarding claim 4, Shaheen teaches transmitting a measurement report including a fictitious neighbor value S7 and S8 (Fig. 7).

Regarding claim 7, Shaheen teaches setting up a data session with the second radio access network; and querying the second radio access network for information relevant to a circuit handover (Fig. 7).

Regarding claim 8, Shaheen teaches transmitting a message via a messaging service, the message including information on the second radio access network, the message indicating a desire to transfer the call from the first radio access network to the second radio access network (Fig. 7).

Regarding claim 18, Shaheen teaches a communication device for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7), the first radio access network using a different mode of communication from the second radio access network (Section 0018), the communication device comprising a transceiver (Fig. 7); a controller coupled to the transceiver, the controller configured to enter an ongoing communication on the first radio access network via the transceiver (Fig. 7); a network detection module configured to detect the presence of a second radio access network S6 (Fig. 7), the second radio access network being unregistered with the first radio access network at initial detection of the presence of the second radio access network while in the ongoing communication (Sections 0039-0043); and a handover module configured to transfer the ongoing communication from the first radio access network to the second radio access network S16-S21 (Fig. 7 and Sections 0006-0009 and 0039-0043), wherein the first radio access network is a cellular radio access network UMTS (Fig. 7) and wherein the second radio access network is a wireless local area network WLAN (Fig. 7).

Regarding claim 20, Shaheen teaches wherein the second radio access network is unregistered with the first radio access network by the first radio access network not initially having information on the second radio access network when the network detection module detects the presence of the second radio access network (Fig. 7 and Sections 0006-0009 and 0039-0043).

Regarding claim 24, Shaheen teaches wherein the controller is further configured to set up a data session with the second radio access network and query the second radio access network for information relevant to a circuit handover S9-S21 (Fig. 7).

Regarding claim 25, Shaheen teaches wherein the controller is further configured to transmit a message via a messaging service, the message including information on the second radio access network, the message indicating a desire to transfer the call from the first radio access network to the second radio access network (Fig. 7).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 5-6 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Boyer et al. (US Pat# 7,050,812).

Regarding claim 5, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system teaches the limitations to claim 1. Shaheen fails to teach a color code.

Boyer's method in channel assignment in a cellular network teaches wherein the fictitious neighbor value includes one selected from the group of a same radio frequency value as a broadcast channel carrier of the serving cell including with a different color code from the broadcast channel carrier of the serving cell, and a frequency value not

used as a broadcast channel of the first radio access network of the serving cell (Col. 26 line 24-Col. 28 line 41).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a color code as taught by Boyer into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to achieve a high degree of quality signals by minimizing the interference (Col. 2 lines 8-12).

Regarding claim 6, the combination including Boyer teaches wherein the color code comprises an information field including a first three bits of a base station identity code (Col. 26 line 24-Col. 28 line 41).

Regarding claim 22, the combination including Boyer teaches a same radio frequency value as a broadcast channel carrier of the serving cell including with a different color code from the broadcast channel carrier of the serving cell, and a frequency value not used as a broadcast channel of the first radio access network of the serving cell (Col. 26 line 24-Col. 28 line 41).

Regarding claim 23, the combination including Boyer teaches wherein the color code comprises an information field including a first three bits of a base station identity code (Col. 26 line 24-Col. 28 line 41).

5. Claims 9 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Stumpert et al. (US Pat Appl# 2004/0157600).

Regarding claim 9, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system teaches the limitations to claim 1. Shaheen fails to teach a short messaging service.

Stumpert's method for determining whether to grant access of a user equipment to a radio access network teaches wherein the messaging service is a short messaging service and wherein the message is a short messaging service message (Sections 0007, 0050, and 0054).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a short messaging service as taught by Stumpert into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to save money and be more efficient (Sections 0004-0005).

Regarding claim 26, the combination including Stumpert teaches wherein the messaging service is a short messaging service and wherein the message is a short messaging service message (Sections 0007, 0050, and 0054).

6. Claims 10, 16-17, 21, 27, and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Ovesjo et al. (US Pat Appl# 2002/0160785).

Regarding claim 10, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system teaches a method in a radio access network for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7), the first radio access network using a

different mode of communication from the second radio access network (Section 0018), the method comprising recognizing an ongoing call of the communication device in a serving cell on the first radio access network (Fig. 7); receiving a measurement report S7 and S8 (Fig. 7) including an identifiable value associated with a serving cell of the first radio access network (Fig. 7); and transferring the call from the first radio access network to the second radio access network S16-S21 (Fig. 7 and Sections 0006-0009 and 0039-0043). Shaheen fails to teach a measurement report of the first radio access network.

Ovesjo's commanding handover between differing radio access technologies teaches a method in a radio access network for handover from a first radio access network to a second radio access network, the first radio access network using a different mode of communication from the second radio access network (Fig.1, Sections 0017-0020), the method comprising recognizing an ongoing call of the communication device in a serving cell on the first radio access network (Fig. 3); receiving a measurement report including an identifiable value associated with a serving cell of the first radio access network (Fig.3 and Sections 0032 and 0037-0038); and transferring the call from the first radio access network to the second radio access network (Fig. 3), wherein the identifiable value associated with the serving cell comprises a fictitious neighbor value (Fig.3 and Sections 0032 and 0037-0038).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a measurement report of the first radio access network as taught by Ovesjo into

Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to have additional parameters in a handover command without lengthening the command message (Section 0016).

Regarding claim 16, the combination including Shaheen teaches wherein transferring the ongoing communication from the first radio access network to the second radio access network comprises switching the connection between the communication device and the connected party via the first radio access network to a connection between the communication device and the connected party via the second radio access network (Fig. 7).

Regarding claim 17, the combination including Shaheen teaches wherein transferring the ongoing communication from the first radio access network to the second radio access network further comprises bypassing the first radio access network (Fig. 7).

Regarding claim 21, the combination including Ovesjo teaches wherein the controller is configured to enter a the ongoing communication by entering a call while operating in a serving cell of the first radio access network (Fig.1, Sections 0017-0020), and wherein the controller is further configured to generate and transmit a measurement report including a fictitious neighbor value associated with the serving cell (Fig. 3 and Sections 0032 and 0037-0038.

Regarding claim 27, Shaheen teaches a controller in a radio access network for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7), the first radio access network using a different mode of

communication from the second radio access network (Section 0018), the controller comprising a communication connection module configured to connect an ongoing communication of the communication device in a serving cell on the first radio access network S2 (Fig. 7); a measurement report module configured to receive a measurement report (Fig.3 and Sections 0032 and 0037-0038); and a handover module configured to transfer the ongoing communication from the first radio access network to the second radio access network (Fig. 3 and). Shaheen fails to clearly teach a measurement report.

Ovesjo teaches a controller in a radio access network for handover from a first radio access network to a second radio access network, the first radio access network using a different mode of communication from the second radio access network (Fig.1, Sections 0017-0020), the controller comprising a communication connection module configured to connect an ongoing communication of the communication device in a serving cell on the first radio access network (Figs. 2 and 3); a measurement report module configured to receive a measurement report (Fig.3 and Sections 0032 and 0037-0038); and a handover module configured to transfer the ongoing communication from the first radio access network to the second radio access network (Fig. 3 and sections 0017-0020), wherein the measurement report comprises a fictitious neighbor value (Fig.3 and Sections 0032 and 0037-0038).

Regarding claim 33, the combination including Shaheen teaches wherein the ongoing communication is transferred from the first radio access network to the second radio access network comprises switching the connection between the communication

device and the connected party via the first radio access network to a connection between the communication device and the connected party via the second radio access network (Fig. 7).

Regarding claim 34, the combination including Shaheen teaches wherein the ongoing communication is transferred from the first radio access network to the second radio access network further by bypassing the first radio access network (Fig. 7).

7. Claims 12, 14, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Ovesjo et al. (US Pat Appl# 2002/0160785) and further in view of Boyer et al. (US Pat# 7,050,812).

Regarding claim 12, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in view of Ovesjo's commanding handover between differing radio access technologies teaches the limitations claim 10. Shaheen and Ovesjo fail to teach a color code.

Boyer's method in channel assignment in a cellular network teaches a same radio frequency value as a broadcast channel carrier of the serving cell including with a different color code from the broadcast channel carrier of the serving cell, and a frequency value not used as a broadcast channel of the first radio access network of the serving cell (Col. 26 line 24-Col. 28 line 41).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate a color code as taught by Boyer into a measurement report of the first radio access network as taught by Ovesjo into Shaheen's method for handoff between a wireless local area

network and a universal mobile telecommunication system in order to achieve a high degree of quality signals by minimizing the interference (Col. 2 lines 8-12).

Regarding claim 14, Boyer further teaches wherein the color code comprises an information field including a first three bits of a base station identity code (Col. 26 line 24-Col. 28 line 41).

Regarding claim 29, Boyer further teaches a same radio frequency value as a broadcast channel carrier of the serving cell including with a different color code from the broadcast channel carrier of the serving cell, and a frequency value not used as a broadcast channel of the first radio access network of the serving cell (Col. 26 line 24-Col. 28 line 41).

Regarding claim 30, Boyer further teaches wherein the color code comprises an information field including a first three bits of a base station identity code (Col. 26 line 24-Col. 28 line 41).

8. Claims 13, 15, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaheen et al. (US Pat Appl# 2004/0203792) in view of Ovesjo et al. (US Pat Appl# 2002/0160785) and further in view of Yahagi (US Pat# 7,065,360).

Regarding claim 13, Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in view of Ovesjo's commanding handover between differing radio access technologies teaches the limitations in claim 10. The combination including Shaheen teaches wherein the second radio access network comprises a wireless local area network WLAN (Fig. 7)

and the first radio access network comprises a cellular radio access network UMTS (Fig. 7). Ovesjo and Shaheen fail to teach the ongoing communication being a call.

Yahagi's multi-network communication system teaches wherein the ongoing communication comprises one of a data session and a call (Fig. 2 and Col. 4 lines 28-31).

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art at the time the invention was made to incorporate the ongoing communication being a call as taught by Yahagi into a measurement report of the first radio access network as taught by Ovesjo into Shaheen's method for handoff between a wireless local area network and a universal mobile telecommunication system in order to make communication easier and receive different services (Col. 1 lines 32-35).

Regarding claim 15, Yahagi further teaches wherein the ongoing communication comprises a connection between the communication device and a connected party (Fig. 2 and Col. 4 lines 28-31).

Regarding claim 31, Yahagi further teaches wherein the ongoing communication comprises one of a data session and a call (Fig. 2 and Col. 4 lines 28-31).

Regarding claim 32, Yahagi further teaches wherein the ongoing communication comprises a connection between the communication device and a connected party (Fig. 2 and Col. 4 lines 28-31).

(10) Response to Argument

1. Appellant's arguments with respect to claims 1, 3-10, 12-18, 20-27, and 29-34 have been fully considered but they are not persuasive.

(A) The appellant argued that Shaheen does not disclose "detecting a presence of a wireless local area network, the wireless local area network being unregistered with the cellular radio access network at initial detection of the presence of the wireless local area network while in the ongoing communication and transferring the ongoing communication from the cellular radio access network to the wireless local area network, as recited in independent Claim 1 and similarly recited in independent claim 18."

In response to the argument (A), the examiner respectfully disagrees with the appellant's argument. Shaheen's invention is almost exactly the same as appellant's invention. According to appellant's specification on page 5 lines 10-14, it defines "the second radio access network 140 may be unregistered with the first radio access network 130 by the first radio access network 130 not initially having information on the second radio access network 140 when the network detection module 290 detects the presence of the second radio access network 140." The same situation is present in Shaheen. In figure 7 of Shaheen it shows that the second radio access network 14 (Fig. 7) is not registered with the first radio access network 12 (Fig. 7) until step S9 (more specifically in S14, Fig. 7). As same with appellant's specification, there is only detection going on in steps S1-S3 to detect the presence of the second radio access network 14 (Fig. 7) but that does not mean the second radio access network 14 (Fig. 7) is registered with the first radio access network 12 (Fig. 7) as is the case in appellant's specification too. Also, nowhere in Shaheen does it states that the second radio access network is registered with the first radio access network until at least at step S9 when

the handover begins. It is clear that the system is just detecting the available wireless local networks in steps S1-S6 and seeing if handover the communication to a second radio access network is better. Then in steps S9-S19 that is when the second radio access network is being registered as indicated by the wording "initiate WLAN service", "access is granted", "authentication", and "complete HO to WLAN" in figure 7. Note, this is the same process as in appellant's figure 4 in steps 430-450.

(B) The appellant argued that "Shaheen et al. and Ovesjo et al. fail to teach a fictitious neighbor value."

In response to the argument (B), the examiner respectfully disagrees with the appellant's argument. The examiner believes the appellant is reading more into the claim than is present. The claim only states "a fictitious neighbor value.". According to appellant's specification on page 7 lines 29-30, a "fictitious neighbor value can be an identifiable value associated with the serving cell". This basically means an identification value of the serving cell. Shaheen teaches receiving ID values associated with the serving cell in steps S1-S3 of figure 7. In order to properly identify a WLAN (second radio access network) there has to be some way of getting an ID value (which is not registering the network just identifying the network). Also, for the sake of argument since fictitious neighbor value is not defined in the claim, another acceptable interpretation can be just a false value. In the measurement report in Shaheen and Ovesjo interference, multi-path fading, calibration issues, etc. can all throw neighbor values (other network values) off and therefore giving a false value (fictitious value).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Andrew Wendell

Art Unit 2618

December 17, 2007

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